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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GARCIA, ERNESTO	
ART UNIT	**PAPER NUMBER**
3679	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/773,250	ALBERTS, MICHAEL J.	
	Examiner	Art Unit	
	Ernesto Garcia	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 October 2006 and 29 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-11 and 13-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-11 and 13-18* is/are rejected.

7)☒ Claim(s) *9-11,13 and 14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on September 6, 2006 and October, 25, 2006 have been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

The drawings were received on September 6, 2006. These drawings are acceptable.

Claim Objections

Claims 1, 9-11, 13, and 15-17 are objected to because of the following informalities:

regarding claims 1, 9, 13, and 15, "the vertical and horizontal members" in claims 1, 13, and 15, line 5-6, and claim 9, line 7, should be --the vertical member and the horizontal member-- otherwise it reads as all the vertical members and the horizontal members of both supports are in one plane;

regarding claim 1, --the-- needs to be inserted before "angle arms" and "like" in line 18 should be --similar--;

regarding claims 2, 3, 9-11, 15, and 16, --like-- in claim 2, line 4, claim 3, lines 5, 8, and 10, claim 9, lines 15-17, 19, and 20, claim 10, lines 4 and 5, claim 11, line 7, claim 15, lines 1, 11, 13, and 14, and claim 16, line 4, should be --similar--;

regarding claim 9, "two" in lines 15 and 16, should be --three-- as the claim has not established two or more stackable fence modules but rather three or more in line 3, and "unitary" in line 16 should be deleted; and,

regarding claim 17, "support" in line 2 should be --supports--. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Double Patenting

Applicant is advised that should claim 6 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Further, applicant is advised that should claim 7 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an

application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

Claims 1-12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the metes and bounds of the claim is unclear. The recitation "when the fence module is oriented for support on the span members" in lines 12-14 makes unclear how the module can be supported on itself, in particular to its span members.

Regarding claims 2 and 15, it is unclear how a spacer 14 is positioned between the angle arm and the inside side edge of both the vertical member and the horizontal member. According to Figure 2b, the spacer 14 is between the angle arm 9 and the inside edge of the vertical member 5 and not the inside edge of the horizontal member. It appears that two spacers should be recited such that one of the spacers is between

the angle arm and the other spacer is between the angle arm and the horizontal member.

Regarding claim 3, the recitation "the first and second end assemblies" in line 3 lacks proper antecedent basis. The recitation "like modules" in line 10 makes unclear whether these are the same like fence modules recited in claim 1, line 18, or other additional like modules than those recited in clam 1, line 18. Further, how does the means for pivotal attachment cooperating with the means for pivotal attachment on the first end support of the similar fence module further limit the fence module. Note that the claim is a fence module and not two fence modules cooperating with the means for pivotal attachment.

Regarding claim 9, the recitation "connected between each of the two end supports of each of the three or more fence modules" in lines 20-21 is misdescriptive since the means for pivot attachment is between the modules and not between the two end supports as the span members are connected therebetween. Further, "the perimeter fence" in line 23 lacks proper antecedent basis.

Regarding claims 9 and 13, the recitation "inside" in claim 9, line 13, and claim 13, line 10, is a relative term, which renders the claim indefinite. The term "inside" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of

the scope of the invention. In other words, what is considered inside when no relationship has been defined to the outside. Further, note that the supports have not been defined as being parallel to each other such that the inside is defined between the supports as claim 1 has been amended.

Regarding claims 4-7, 17, and 18, the claim depends from claim 1 and therefore is indefinite.

Regarding claims 10 and 11, the claims depend from claim 9 and therefore are indefinite.

Regarding claim 14, the claim depends from claim 13 and therefore is indefinite.

Claim Rejections - 35 USC § 102

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lape, 257,168.

Regarding claim 1, Lape discloses, in Figure 1, a unitary, stackable fence module comprising: two end supports (one side view of a support is shown in Figures 1 and 4), and span members **a, a'**. The two end supports are spaced apart and forming an inside therebetween. Each end support has a substantially vertical member **B, B'**, a horizontal member **D, D'**, and an angle arm **A, A'**. The vertical member **B, B'** is connected at a

lower end to a first end of the horizontal member **D, D'**. The vertical member **B,B'** and the horizontal member **D, D'** are in the same plane. The angle arm **A, A'** is connected between an inside of the upper end **J** of the substantially vertical member **B, B'** and an inside of a second end **H** of the horizontal member **D, D'**. The vertical member **B, B'** and the horizontal member **D, D'** are in the same plane. The span members **a, a'** are connected between the angle arm **A, A'** of each end support, spacing the end supports apart.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by McKinnon, 1,545,909.

Regarding claim 1, McKinnon discloses, in Figure 3, a unitary, stackable fence module comprising: two end supports (one side view of a support is shown in Figure 2), and span members **2**. Each end support has a substantially vertical member **9**, a horizontal member **11**, and an angle arm **4**. The vertical member **9** is connected at a lower end to a first end of the horizontal member **11** and the angle arm **4**. The angle arm **4** is connected between an upper end of the substantially vertical member **9** and a second end of the horizontal member **11**. The vertical member **9** and the horizontal member **11** are in the same plane (note that their sliding surfaces share a plane). The span members **2** are connected between the angle arm **4** of each end support, spacing the end supports apart, wherein, the angle arm **4** is attached to an inside side edge of

each of the substantially vertical member **9** and the horizontal member **11** adjacent the span members **2**.

Claim Rejections - 35 USC § 103

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lape, 257,168.

Regarding claim 15, Lape discloses, in Figure 1, a unitary, stackable fence module comprising: two end supports (one side view of a support is shown in Figures 1 and 4), and span members **a, a'**. The two end supports are spaced apart and forming an inside therebetween. Each end support has a substantially vertical member **B, B'**, a horizontal member **D, D'**, and an angle arm **A, A'**. The vertical member **B, B'** is connected at a lower end to a first end of the horizontal member **D, D'**. The vertical member **B,B'** and the horizontal member **D, D'** are in the same plane. The angle arm **A, A'** is connected between an inside of the upper end **J** of the substantially vertical member **B, B'** and an inside of a second end **H** of the horizontal member **D, D'**. The vertical member **B, B'** and the horizontal member **D, D'** are in the same plane. The span members **a, a'** are connected between the angle arm **A, A'** of each end support, spacing the end supports apart.

However, Lape fails to disclose more than one unitary, stackable fence module similar to the fence module as disclosed by Lape and shown in Figure 5. Applicant is reminded that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the same unitary, stackable fence module shown in Figure 5 for mass production to fulfills orders. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon, 1,545,909.

Regarding claim 15, McKinnon discloses, in Figure 3, a unitary, stackable fence module comprising: two end supports (one side view of a support is shown in Figure 2), and span members **2**. Each end support has a substantially vertical member **9**, a horizontal member **11**, and an angle arm **4**. The vertical member **9** is connected at a lower end to a first end of the horizontal member **11** and the angle arm **4**. The angle arm **4** is connected between an upper end of the substantially vertical member **9** and a second end of the horizontal member **11**. The vertical member **9** and the horizontal member **11** are in the same plane (note that their sliding surfaces share a plane). The span members **2** are connected between the angle arm **4** of each end support, spacing the end supports apart, wherein, the angle arm **4** is attached to an inside side edge of

each of the substantially vertical member **9** and the horizontal member **11** adjacent the span members **2**.

However, McKinnon fails to disclose more than one unitary, stackable fence module similar to the fence module as disclosed by McKinnon and shown in Figure 1. Applicant is reminded that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the same unitary, stackable fence module shown in Figure 1 for mass production to fulfills orders. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 2, 6, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lape, 257,168, as applied to claim 1, and further in view of Kummerlin et al., 4,502,564.

Regarding claims 2 and 16, Lape, as discussed, fails to disclose a spacer positioned between the angle arm and the inside side edge of the vertical member. Kummerlin et al. teach a spacer 117 (col. 7, lines 31-34) positioned between an angle arm and an inside side edge of a vertical member and a horizontal member to act as a bearing between the angle arm and the inside side edge of the vertical member and the horizontal member. Therefore, as taught by Kummerlin et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a

spacer between the angle arm and the inside side edge of the vertical and horizontal members to behave as a bearing between the inside side edge of the vertical and horizontal members and the angle arm.

Regarding claims 6 and 17, Lape, as discussed, fails to disclose the end supports and the span members formed of tubular steel. Applicant is reminded that making the end supports and the span member of tubular steel is an obvious matter of design choice as tubular steel is readily available as a stock material. Further, Kummerlin et al. is provided as evidence that tubular steel is well known to make span member and end supports.

Claims 3, 4, and 8 are rejected under 35 U.S.C 103(a) as being unpatentable over McKinnon, 1,45,909, as applied to claim 1, and further in view of Faught, 300,455.

Regarding claim 3, McKinnon shows the end supports being a first end support and a second end support. However, the first end support and the second end support do not have attachment means attached to the vertical member to permit pivotal attachment to a subsequent fence module. However, Faught teaches using an attachment means to permit pivotal attachment, in Figures 1, as seen between the modules to permit pivotal attachment between modules to create a pivotal fence to be set at different angles. Therefore, as taught by Faught, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a pivotal

attachment as taught by Faught to allow the fence module of McKinnon to be set at different angle with respect to another module.

Regarding claim 4, a pin and loops are arranged along each vertical member so as to permit vertical alignment of the loops between the second end of the first fence module and the first end of a subsequent fence module to permit passage of the pin therethrough.

Regarding claim 8, given the teachings of Faught, it would have been obvious matter of design choice to enclose an area by placing the module and subsequent modules pivotally connected to form a polygonal shape.

Claim 5 is rejected under 35 U.S.C 103(a) as being unpatentable over McKinnon, 1,45,909, in view of Faught, 300,455, as applied to claims 3, 4, and 8, and further in view of Walter, 197,806.

Regarding claim 5, McKinnon, as discussed, fails to disclose the pin being of sufficient length to engage a ground. Walter teaches, in Figure 1, a pin A' being of sufficient length to engage a ground to anchor modules. Therefore, as taught by Walter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pin of Walter to replace the pivotal connection provided

by Faught, to anchor the modules and to allow the modules to rotate relative to each other.

Claim 6 is rejected under 35 U.S.C 103(a) as being unpatentable over McKinnon, 1,545,909, in view of Neely, 1,214,705.

Regarding claim 6, McKinnon, as discussed, fails to disclose the supports and the span members formed of tubular steel. Neely teaches, in Figure 1, end supports and span member formed of tubular steel as part of a design choice to make a module. Therefore, as taught by Neely, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the supports and the span members formed of tubular steel to make the fence module more aesthetic or light weight.

Claims 7 and 18 are rejected under 35 U.S.C 103(a) as being unpatentable over McKinnon, 1,45,909, as applied to claim 1, and further in view of St. John, 5,533,714.

Regarding claim 7, as discussed, McKinnon fails to disclose the module further comprising a man door formed intermediate the span members. St. John teaches, in Figure 7, a man door formed intermediate span members to allow access to an enclosure made by more than one module. Therefore, as taught by St. John, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to place a man door formed intermediate the span member of McKinnon to allow access to an enclosed area formed by placing more than one module of McKinnon.

Allowable Subject Matter

Claims 9-11, 13, and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claims 9 and 13, the prior art of record does not disclose or suggest a fence system comprising angle arms of two end supports of each of three or more fence modules, fitting between a horizontal member and a substantially vertical member of a previous module in a nested arrangement (claim 9, lines 16-18; claim 13, lines 12-14). The closest prior art to McKinnon, 1,546,909, discloses a module as claimed; however, there is no motivation, absent applicant's own disclosure, to modify McKinnon because the angle arms of the two end supports are not nested so that the arms fit between a horizontal member and a substantially vertical member of a previous module;

regarding claim 10 and 11, these claims directly or indirectly depend from claim 9; and,

regarding claim 14, this claim depends from claim 13.

Response to Arguments

Applicant's arguments against Lape, filed October 25, 2006, have been fully considered but they are not persuasive. In particular, note the 35 U.S.C 112(2nd) rejection. Further, applicant argues that Lape teaches a ladder and a ladder is not a fence. In response, applicant is reminded that an argument against non-analogous art does not apply against a 35 U.S.C 102(b) rejection and therefore the argument is moot. Further, note that the rejected claims are directed to a module and not modules that are stacked. Lape, as provided, teaches the structural limitations of a module and the term stackable is given its broadest reasonable interpretation since anything can be stacked in any fashion.

Applicant's arguments against Lape in view of Kummerlin et al. have been fully considered but they are not persuasive. Applicant's argues that the spacer of Kummerlin et al. does "not assist in making the ladders of Lape stackable as contemplated by Applicant". In response, the examiner has different reasons for combination the references since the rejected claims are not directed to stacked fenced modules but rather a module or the plurality of modules as presented in the new claim 15. In particular, note that claim 1 is directed to a fence module. The fact that is has the purpose of being stacked does not differentiate over the prior art. Note that patentability is based on structural differences over the prior art and not based on how the module is used or employed.

Applicant's arguments against McKinnon, filed October 25, 2006, have been fully considered but they are not persuasive.

Applicant argues that McKinnon cannot stack nor does McKinnon contemplate stacking. In response, applicant is reminded that the claims are directed to a unitary, stackable fence module and not fence modules that are stacked as disclosed in the specification. Applicant has focused this argument on the intended use of the module rather than the structural differences between the claimed fence module and the prior art. Applicant argues that "the horizontal member 11 is not in the same plane at each of its ends". In response, the examiner has pointed out that the plane is shared between the horizontal member and the vertical member at the sliding interface, thus the horizontal member is in the same plane that the vertical member is located. The fact that the horizontal member is in two parts is irrelevant when one of the two parts meets the claimed location. Further, there is nothing in the claim that indicates that the plane extends from end to end of the horizontal member or the ends are in the same plane as applicant alleges.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. White et al., 659,117, show a similar fence module.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-282-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

December 27, 2006

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